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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/348,529	07/07/1999	ALAN SLATER	CITI0109-US	5359
27510 7590 07/27/2007 KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			EXAMINER FELTEN, DANIEL S	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 07/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/348,529	<b>Applicant(s)</b> SLATER ET AL.	
	<b>Examiner</b> Daniel S. Felten	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 50-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Receipt of the Request for Continued Examination ("RCE") filed March 30, 2007 is acknowledged.
2. Receipt of applicant's Response/Amendment filed May 11, 2007 is acknowledged. Claims 1-49 have been cancelled without prejudice or disclaimer. Claims 50, 53, 55, 77, 92, 97 have been amended. Claims 50-101 are pending in the application and are presented to be examined upon their merits.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on March 30, 2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. The "whereby" clauses in claims 55, 77, 92 and 97 suggests or makes optional the step(s) the pickup of the check received at the first location.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 55-101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "can be" delayed or eliminated is indefinite because the step is not required to be performed, but only the potential to be performed.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 50-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustin et al (US 5,829,625) in view of Wensink et al (US 5,431,389)

**As in per claims 50, 53, 55, 77, 92**, a method for image based transactions (see Gustin, Abstract), wherein receiving at a first location cash for wire transfer and cash (*and art recognized equivalents e.g., checks and cash money orders*) having a front face and a back face (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ );

Scanning the front and back face of the cash money order to create an electronic validation of deposited cash (see Gustin, fig. 13K, Abstract; column 4, lines 3-8; column 18, lines 3-7);

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Transmitting the electronic validation of deposited cash from the first location to a second location (see column 4, lines 42-56); and

Processing a transaction at the second location with the electronic validation of deposited cash (see column 4, lines 42-56)

Gustin does not explicitly disclose that the cash is in the form of paper per se. However it would have been obvious for one of ordinary skill in the art to recognize that the fact that paper checks and paper money orders as cash equivalents inasmuch as they are may be converted into legal tender to be used to pay for goods and services. Also it is well known within the banking industry art that cash, checks and money orders are scanned and stored into a database for security, monitoring and tracking purposes. Wesink discloses a scanner that is used in the banking industry to replace microfiche documents of legal tender (or cash) (see Wensink, column 6, lines 50-64). It would have been obvious to modify Gustin to provided scanning of paper cash so as to provide a means for monitoring and tracking legal tender (paper cash or money). Such a modification would provide added convenience to the customer and security during fund transactions.

**As per claim 51, 56** further comprising the step of displaying an image of the scanned cash on a terminal display (fig. 19E,) (648) at the first location to provide confirmation to a customer that the deposit has been accepted (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+; and column 19, lines 34-49 );

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**As per claim 52**, separately entering the amount of the cash which has been scanned, comparing the amount entered with the amount scanned, and if the scanned amount matches the entered amount, conducting the processing of the transaction (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ );

**As per claims 54, 57, 80** further comprising displaying an image of the scanned check on a terminal display at the first location to provide confirmation to a customer that the deposit has been accepted (see Gustin, figs. 13, 13H, 14, 16A, 18B, 19E Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ );

**As per claim 58**, wherein the scanning is conducted on the check and further comprising recreating the image of the scanned deposited check onto paper (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ );

**As per claim 59**, wherein said recreating of the check onto paper further comprises cutting the paper to the size of a check.

**As per claim 60, 82,,** wherein said recreating of the check onto paper is done at the second location. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 61**, wherein said first location is an automatic teller machine, owned and operated by a bank for its customers, having a scanner and display, and the method further comprising storing the scanned check in the automatic teller machine (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

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**As per claim 62, 81, 84, 88,** further comprising recreating the scanned deposited check into a paper image which is Magnetic Image Character Recognition (MICR) encoded. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 63,** The method of claim 55, further comprising separately entering the amount on the check which has been scanned, comparing the amount entered with the amount scanned, and if the scanned amount matches the entered amount, conducting the processing of the transaction. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 62,** encrypting and digitally signing the check before the transmission to the second location for processing. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 65,** wherein said first location is an automatic teller machine, owned and/or operated by someone other than the owner of the second location. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 66, 90** wherein said first location is a branch of a bank (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 67,** wherein said first location is a retail business location. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

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**As per claim 68, 91** wherein said first location is a business (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 69**, wherein said first location is outside the United States. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 70**, further comprising voiding said check at the first location by printing on the check or destroying the check. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 71**, further comprising endorsing the check. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 72**, further comprising transmitting the image to another location to display to an operator for resolution if the amounts entered and scanned differ. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 73**, further comprising comparing the information on the check to information contained in a file of indicators of potential loss. (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 74**, further comprising maintaining a file of payor bank preferences for how the payor bank will receive presentment, and processing the transaction in



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accordance with the preferences (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 75, 81** further comprising using the information in the payor bank preference file to determine whether presentment will be by paper, Extended Capabilities Port (ECP), image, or Automatic Clearing House (ACH) (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ )

**As per claim 76**, further comprising maintaining a file of routing preferences, and processing the transaction in accordance with the preferences (see Gustin, fig. 13 Abstract; column 4, lines 3-8; column 18, lines 3-7; and column 13, lines 5+ ).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel S Felten  
Examiner  
Art Unit 3693

DSF  
7/19/2007